

**REMARKS**

This is in full and timely response to the Office Action of December 13, 2004 in this RCE application. A petition to extend time for this response to within the third extended month accompanies this submission.

Claims 11, 12, 17, 18, 27, 28, 39, 40, 53, 54, 63, 65, 73 and 74 were pending following entry of the preliminary amendment for this RCE application. All of these claims were initially rejected on the basis of Noguchi, No. 5,529,951 (alone as in claims 11, 27, 39, 53, 63, and 73 under 35 USC 102(b); or with other references (as in claims 12, 28, 40, 54, 65 and 74 with Tanaka No. 5,798,744; or as in claim 17 with Yamazaki, No. 6,037,197; or as in claim 18 (with Tanaka and Yamazaki). At the bottom of all rejections was the notion that a limitation such as in claim 27 ("said semiconductor thin film is accumulated by alternately repeating said film forming step and said irradiation step without exposing said substrate to the air") is a product by process limitation of producing a thin film with more thickness. This position is again traversed.

Reference is made to the Decision on Appeal in the parent application dated December 30, 2004 (copy attached, often referred to merely as the "Board decision"). At the outset, it should be noted that claims 27 and 28 in a form that included that or an equivalent recitation were before the Board in the appeal in the parent application. The issue of product by process was fully briefed by the examiner and by the Applicant in the exchanges prior to the Board decision. In its admonition beginning at page 5 of the Board Decision on Appeal, the Board considered the language of the claim itself. Its consideration of the claims on appeal is loudly silent on the issue of "product by process", reaching the merits of the pending claims by its focus on independent claim 11 and its finding relative to a "borderless irradiated regions". Thus, the Board declined to adopt the position of the examiner there on this same issue of "product by process" limitations. The decision of the Board is therefore at the very least the law of the case on the points there presented (on which it could have or did base its decision), and may also constitute res judicata and collateral estoppel against relitigating the same points by the examiner.

To restate the position of the Board, "claim interpretation must begin with the language of the claim itself." To take advantage of the finding of the Board, the Applicant filed this RCE application specifically reciting the "borderless irradiated regions" found to be wanting in the recitations of the claims on appeal. Then, the examiner provided new grounds of rejection with

the same factual error in ignoring the limitations litanied on page 3 and 4 of the Action. All of the language of the claims must be considered, especially in view of the advice to the Applicant in the paper of June 10, 2003, reversedly paraphrased as “patentable weight will be given to the process steps which do add structural limitations to the final product”. Even that test is met by the additional limitations added to each of the independent claims except for claims 27 and 28 where like or similar recitations already resided.

Withdrawal of the rejections as stated is proper as erroneous in light of the Board decision that could have, but did not, side with the examiner in a properly briefed issue involving process steps in these types of claims. But, even if the issue of interpretation is otherwise open, the Applicant has met the test of the Office in its June 10, 2003 paper.

As to claims rejected on the basis of section 102, the law stated by the Board continues to be applicable, and the interpretation of the Board continues to be sound. The error of the examiner, therefore, in the factual finding or legal conclusion drawn is in ignoring expressed limitations in these claims.

#### The section 103 rejections

Each of the section 103 rejections is also based on Noguchi '951 as applied to claims 11, 27, 39, 53, 63 and 73. Therefore each of the section 103 rejections must also fall in the first instance as based on an erroneous claim interpretation. To that extent, the prior arguments are incorporated by reference as if fully repeated herein.

Moreover, the section 103 rejections are flawed on another front. Each fails to meet the proper standards for supporting findings of a reason or motivation to combine the references. See the statement of obviousness on page 4, section 5 of the Action, and at the top of pages 5, the sentence spanning pages 5 and 6, and in section 7 on page 6 of the Action. None of those findings is supported by a factual finding of why one of skill in the art would be motivated or prompted to pick and choose bits of disclosure from the secondary references to add to Tanaka. In that respect, therefore, all of the section 103 rejections are faulty. See In re Sang Su Lee, Appeal 00-1158 (Fed. Cir. January 18, 2002). There, it is well articulated that the prior art analysis includes evidence relevant to a finding of whether there is teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. The factual question of motivation is material to patentability, and can not be resolved on subjective belief and unknown authority.

It is important that one of ordinary skill be led to the claimed invention by the maze of the art cited, rather than by the Applicant's disclosure. It is improper merely to use that which the inventor taught against its teacher. Thus, the Office must not only assure that the requisite findings are made, based on evidence of record, but also must explain the reasoning by which the findings are deemed to support the PTO's conclusion.

### Conclusion

All issues having been addressed, applicant believes that all claims are in condition for allowance, and notice to that effect is requested. In view of the above amendment and arguments, the Applicant submits the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. SON-1718 from which the undersigned is authorized to draw.

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Respectfully submitted,

By 

Ronald P. Kananen

Registration No.: 24,104

Robert S. Green

Registration No.: 41,800

RADER, FISHMAN & GRAUER PLLC

1233 20th Street, N.W.

Suite 501

Washington, DC 20036

(202) 955-3750

Attorneys for Applicant